

**REMARKS:**

Claims 2, 4-30, and 32-45 are currently pending in the application. Claims 2, 4-30, and 32-45 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,787,000 to Lilly et al. ("*Lilly*") in view of U.S. Patent No. 5,548,518 to Dietrich et al. ("*Dietrich*") and in further view of U.S. Patent No. 5,111,391 to Fields et al. ("*Fields*").

A Final Office Action in the subject Application was mailed to the undersigned on 30 January 2006, which provides for a response period ending 30 April 2006. The Applicants filed an Amendment After Final on 24 February 2006, within two (2) months of the date of the Final Office Action. An Advisory Action was mailed to the undersigned on 15 March 2006. The Advisory Action stated that the proposed Amendments filed on 24 February 2006 will not be entered because they raise new issues that would require further consideration and/or search. (15 March 2006 Advisory Action, Page 1). The Applicants respectfully disagree and reiterate here the arguments set forth in the Amendment After Final filed on 24 February 2006, as if fully set forth herein.

Although the Applicants believe that claims 2, 4-30, and 32-45 are directed to patentable subject matter and are in condition for allowance without amendment. The Applicants have amended independent claims 2, 4, and 32 to more particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. By making these amendments, the Applicants makes no admission concerning the merits of the Examiner's rejection, and respectfully deny any statement or averment of the Examiner not specifically addressed. Particularly, the Applicants reserve the right to file additional claims in this Application or through a continuation patent Application of substantially the same scope of originally filed claims 2, 4-30, and 32-45. No new matter has been added.

## **REJECTION UNDER 35 U.S.C. § 103(a):**

Claims 2, 4-30, and 32-45 stand rejected under 35 U.S.C. § 103(a) over *Lilly* in view of *Dietrich* and in further view of *Fields*.

Although the Applicants believe that claims 2, 4-30, and 32-45 are directed to patentable subject matter and are in condition for allowance without amendment. The Applicants have amended independent claims 2, 4, and 32 to more particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicants respectfully submit that *Lilly*, *Dietrich*, or *Fields* either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 2, 4-30, and 32-45. Thus, the Applicants respectfully traverse the Examiner's obvious rejection of claims 2, 4-30, and 32-45 under 35 U.S.C. § 103(a) over the proposed combination of *Lilly*, *Dietrich*, or *Fields*, either individually or in combination.

### **The Proposed *Lilly-Dietrich-Fields* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims**

For example, with respect to amended independent claim 2, this claim recites:

A method for ***scheduling development planning for a plurality of products of an enterprise***, comprising:

- receiving a list of a plurality of products to be developed;
- receiving a list of required completion dates, each completion date specifying the completion date for the development of a corresponding product in the plurality of products;

- receiving, for each product in the plurality of products, a project definition of a project for developing the product, each project definition defining:

- a plurality of phases associated with the project for developing the product, the plurality of phases having a plurality of tasks required to complete a project for developing the product associated with the project definition***; and

- a list of resources required to complete each task defined in the product definition, at least one of the plurality of tasks for at least one

of the plurality of projects requiring a material to be provided by an outside party distinct from the enterprise;

receiving **a list of available resources, each resource in the list of available resources comprises:**

**a capacity level, representing a function of time available to each resource;**

**an availability level, representing a function of duration available to each resource; and**

**an ability level, including an attribute level, representing a function of work characteristic capable of being performed by each resource and a competency level, representing a function of competence of each resource;**

receiving, **for each task associated with each phase of the project definition requiring a resource, a specified minimum ability level of one or more resources to be used for that task;**

**receiving a list of materials available from outside parties distinct from the enterprise and a schedule of availability of the materials available from the outside parties; and**

**maintaining a scheduler operable to automatically generate a development schedule comprising all tasks for all projects, the development schedule allocating the resources such that each resource is allocated at a level less than or equal to its capacity, the development schedule also allocating the resources that have an ability level at least as high as the specified minimum ability level, the development schedule also scheduling tasks that require materials from outside parties at a time when such materials will be available. (Emphasis Added).**

Amended independent claims 4 and 32 recite similar limitations. *Lilly, Dietrich, and Fields*, either individually or in combination, fail to disclose each and every limitation of amended independent claims 2, 4, and 32.

The Applicants respectfully maintain that *Lilly* has nothing to do with amended independent claim 2 limitations regarding “**scheduling development planning for a plurality of products of an enterprise**” and in particular *Lilly* has nothing to do with amended independent claim 2 limitations regarding “receiving, for each product in the plurality of products, a project definition of a project for developing the product, each project definition defining: **a plurality of phases associated with the project for developing the product, the plurality of phases having a plurality of tasks required to complete a project for developing the product associated with the project definition**; and a list of resources required to complete each task defined in the

product definition, at least one of the plurality of tasks for at least one of the plurality of projects requiring a material to be provided by an outside party distinct from the enterprise". Rather *Lilly* discloses a system for scheduling work orders in a manufacturing process. (Abstract). The work order scheduling of *Lilly* merely provides for a computerized schedule of ***specified operations*** to be performed in a manufacturing process. *Lilly* does not disclose, teach, or suggest ***"a plurality of phases associated with the project for developing the product."*** In addition, *Lilly* does not disclose, teach or suggest a ***"the plurality of phases having a plurality of tasks required to complete a project for developing the product associated with the project definition."***

The Applicants further maintain that the Office Action acknowledges, and the Applicants agree, that *Lilly* fails to disclose the emphasized limitations noted above in amended independent claim 2. Specifically the Examiner acknowledges that *Lilly* fails to disclose ***"receiving a list of materials available from outside parties distinct from the enterprise and a schedule of availability of the materials available form the outside parties"*** and ***"the development schedule also scheduling tasks that require materials from outside parties at a time when such materials will be available."*** (30 January 2006 Office Action, Page 6). However, the Examiner asserts that the cited portions of *Dietrich* disclose the acknowledged shortcomings in *Lilly*. The Applicants respectfully disagree. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in *Dietrich*.

The Applicants respectfully maintain that *Dietrich* has nothing to do with amended independent claim 2 limitations regarding ***"scheduling development planning for a plurality of products of an enterprise"*** and in particular *Dietrich* has nothing to do with amended independent claim 2 limitations regarding ***"receiving a list of materials available from outside parties*** distinct from the enterprise ***and a schedule of availability of the materials available form the outside parties"*** and ***"the development schedule also scheduling tasks that require materials from outside parties at a time when such materials will be available."*** Rather *Dietrich* discloses an allocation method for generating a production schedule. (Abstract). The allocation method in *Dietrich* is

merely provided in response to a specified requirement and allocates a quantity of supply components for fulfilling a partial order and filing the remainder of the requirement at some later time. (Abstract). In particular, the Examiner equates “**scheduling tasks that require materials from outside parties at a time when such materials will be available**” recited in amended independent claim 2 with the external availability schedule disclosed in *Dietrich*. (4 October 2005 Final Office Action, Page 2). However, the external availability schedule disclosed in *Dietrich* is associated with a list of periods during which the part number can be completed, in favor of the part numbers with higher priority. (Column 3, Lines 8-11 and Column 4, Lines 40-45). In contrast, the scheduler recited in amended independent claim 2 is provided for “**scheduling development planning for a plurality of products of an enterprise**”. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s comparison between *Dietrich* and amended independent claim 2 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish amended independent claim 2 from *Dietrich*.

The Applicants respectfully maintain that the Office Action acknowledges, and the Applicants agree, that *Lilly* and *Dietrich* fail to disclose the emphasized limitations in amended independent claim 2. Specifically the Examiner acknowledges that the *Lilly* and *Dietrich* combination fails to disclose “**the required resources having an ability level and each task specifying a minimum ability level of one or more resources to be used for that task.**” (30 January 2006 Office Action, Pages 6-7). The Applicants noted in the previous response dated 2 November 2005, that (in the previous Office Action) the Examiner failed to cite any specific portion of *Fields* in support of the Examiner’s position that *Fields* discloses the acknowledged shortcomings in *Lilly* and *Dietrich*. In response, the Examiner (in the present Office Action) asserts that “*Field* teaches tasks having a required skill level and also the employees having a skill level which are used to assign employees to tasks in Column 6, Lines 21-65. (30 January 2006 Office Action, Page 4). The Applicants respectfully disagree. The Applicants respectfully traverse the Examiner’s assertions regarding the subject matter disclosed in *Fields*.

The Applicants respectfully maintain that *Fields* has nothing to do with amended independent claim 2 limitations regarding “**scheduling development planning for a plurality of products of an enterprise**” and in particular *Fields* has nothing to do with amended independent claim 2 limitations regarding “receiving a **list of available resources, each resource in the list of available resources comprises: a capacity level**, representing a function of time available to each resource; **an availability level**, representing a function of duration available to each resource; and **an ability level**, including **an attribute level**, representing a function of work characteristic capable of being performed by each resource and **a competency level**, representing a function of competence of each resource”. In particular, it appears that the Examiner is equating “**list of available resources**” recited in amended independent claim 2 with the “Employee Schedule Record” disclosed in *Fields*. (30 January 2006 Office Action, Page 4). However, the “Employee Schedule Record” disclosed in *Fields* merely “contains one record per scheduled employee with that employee’s name, skill level and the start-time and stop-time”. (Column 6, Lines 21-65). In contrast, the “**list of available resources**” recited in amended independent claim 2 comprises “**a capacity level**, representing a function of time available to each resource; **an availability level**, representing a function of duration available to each resource; and **an ability level**, including **an attribute level**, representing a function of work characteristic capable of being performed by each resource and **a competency level**, representing a function of competence\_of each resource”. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s comparison between *Fields* and amended independent claim 2 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish amended independent claim 2 from *Fields*.

The Applicants further respectfully maintain that *Fields* has nothing to do with amended independent claim 2 limitations regarding “receiving, **for each task associated with each phase of the project definition requiring a resource, a specified minimum ability level of one or more resources to be used for that task**”. Rather *Fields* discloses a staff scheduling data processing system. (Abstract). This data processing system in *Fields* is merely a database for storing and retrieving

information associated with staff and management personal. *Fields* does not disclose, teach, or suggest “receiving, **for each task associated with each phase of the project definition requiring a resource, a specified minimum ability level of one or more resources to be used for that task**”.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Lilly*, *Dietrich*, and *Fields*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Lilly*, *Dietrich*, and *Fields* as proposed. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art to include *Fields* specification of a skill level for each task and subsequent skill levels of resources (employees) in order to more efficiently allocate each resource to a task.” (30 January 2006 Office Action, Page 7). The Applicants respectfully disagree.

The Applicants further submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Lilly*, *Dietrich*, or *Fields*, either individually or in combination. In essence, the Examiner asserts that one of ordinary skill in the art, at the time of the invention, would have been motivated because “by allocating based on required skill level, **each task would be completed by the most qualified resource** thereby **ensuring highest quality products**.” (30 January 2006 Office Action, Page 7). The Applicants respectfully disagree.

The Applicants do not understand the Examiner’s assertion that “**each task would be completed by the most qualified resource**” or the Examiner’s assertion of “**ensuring highest quality products**”. The Applicants respectfully submit that each ability level, in the subject application, and as recited in amended independent claim 2, is provided for a minimum competency or experience level for the resource. So if for example, a higher competency resource is used for the task, the duration may be shortened by an amount proportional to the skill differential, likewise, if a lower competency resource is used for the task, the duration may be increased by an amount proportional to the skill differential. In

essence, the change in duration based upon the competency is application dependent and is not the same as "***each task would be completed by the most qualified resource***" or even of "***ensuring highest quality products***". Thus, ***the Applicants respectfully request the Examiner to point to the portions of Lilly, Dietrich, or Fields which contain the teaching, suggestion, or motivation to combine Lilly, Dietrich, or Fields for the Examiner's stated purported advantage.*** The Applicants further submit that the Examiner is using the subject Application as a template to formulate ***reconstructive hindsight, which constitutes impermissible use of hindsight*** under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, ***the Examiner has not adequately supported the selection and combination of Lilly, Dietrich, and Fields to render obvious the Applicants claimed invention.*** The Examiner's conclusory statements that it would have been obvious "it would have been obvious to one of ordinary skill in the art to include *Fields* specification of a skill level for each task and subsequent skill levels of resources (employees) in order to more efficiently allocate each resource to a task" and that "by allocating based on required skill level, each task would be completed by the most qualified resource thereby ensuring highest quality products" ***do not adequately address the issue of motivation to combine.*** (30 January 2006 Office Action, Page 7). This factual question of motivation is material to patentability, and can not be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the teachings of Lilly, Dietrich, or Fields***, either individually or in combination.



**The Proposed *Lilly-Fields* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Dependent Claims 5, 18, and 33**

For example, with respect to dependent claim 5, this claim recites:

The method of Claim 2, ***wherein each task is associated with a task definition comprising at least one of:***

type information identifying the type of task;  
hierarchy relationship information comprising one or more pointers to one or more related tasks and information regarding a sequence for performing related tasks;  
duration information specifying a quantity of time the task will take to complete;  
***resource information specifying one or more resources to be used and a desired ability***; and  
progress information specifying progress of the particular task.  
(Emphasis Added).

Dependent claims 18 and 33 recite similar limitations. *Lilly* and *Fields*, either individually or in combination, fail to disclose each and every limitation of dependent claims 5, 18, and 33.

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that *Lilly* fails to disclose the emphasized limitations in dependent claim 5. Specifically the Examiner acknowledges that *Lilly* fails to disclose ***“the required resources having an ability level.”*** (30 January 2006 Office Action, Pages 7-8). However, the Examiner asserts that the cited portions of *Fields* disclose the acknowledged shortcomings in *Lilly*. The Applicants respectfully disagree. The Applicants respectfully traverse the Examiner’s assertions regarding the subject matter disclosed in *Fields*.

The Applicants further respectfully submit that *Fields* has nothing to do with dependent claim 5 limitations regarding ***“wherein each task is associated with a task definition”*** comprising ***“resource information specifying one or more resources to be used and a desired ability”***. Rather, as discussed above, *Fields* discloses a staff scheduling data processing system. (Abstract). *Fields* does not disclose, teach, or suggest the desired ability ***“including an attribute level, representing a function of work characteristic capable of being performed by each resource and a***

**competency level, representing a function of skill of each resource**", as recited in amended independent claim 2. Thus, *Fields* cannot provide "**wherein each task is associated with a task definition comprising at least one of:** type information identifying the type of task; hierarchy relationship information comprising one or more pointers to one or more related tasks and information regarding a sequence for performing related tasks; duration information specifying a quantity of time the task will take to complete; **resource information specifying one or more resources to be used and a desired ability**; and progress information specifying progress of the particular task", since *Fields* does not even provide an ability level, an attribute level, or even a competency level in the first place.

The Applicants further respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Lilly* or *Fields*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that "it would have been obvious to one of ordinary skill in the art to include *Fields* specification of a skill level for each task and subsequent skill levels of resources (employees)". (30 January 2006 Office Action, Pages 7-8). The Applicants respectfully disagree.

The Applicants further submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Lilly* or *Fields*, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be "in order to **more efficiently allocate each resource to a task**" and by "allocating based on required skill level, each task would be **completed by the most qualified resource thereby ensuring highest quality products**." (30 January 2006 Office Action, Pages 7-8). The Applicants respectfully disagree and further respectfully requests clarification as to how the Examiner arrives at this conclusion. For example, how does the Examiner's assertion of "allocating based on required skill level" apply to "**resource information specifying one or more resources to be used and a desired ability**" in the subject Application. (30 January 2006 Office Action, Pages 7-8). *The*

***Applicants respectfully request the Examiner to point to the portions of Lilly or Fields which contain the teaching, suggestion, or motivation to combine these references for the for the Examiner's stated purported advantage.*** In particular, the Applicants respectfully request the Examiner to point to the portions of *Lilly* or *Fields* which show the Examiner's state purported advantage of "allocating based on required skill level" is somehow related to "***resource information specifying one or more resources to be used and a desired ability***" and how the desired ability includes "***an attribute level, representing a function of work characteristic capable of being performed by each resource and a competency level, representing a function of skill of each resource***". The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the ***Examiner has not adequately supported the selection and combination of Lilly or Fields to render obvious the Applicants claimed invention.*** The Examiner's conclusory statements that "it would have been obvious to one of ordinary skill in the art to include *Fields* specification of a skill level for each task and subsequent skill levels of resources (employees)" and that "in order to ***more efficiently allocate each resource to a task***" and by "allocating based on required skill level, each task would be ***completed by the most qualified resource thereby ensuring highest quality products***", ***does not adequately address the issue of motivation to combine.*** (30 January 2006 Office Action, Pages 7-8). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office***

**Action fails to provide proper motivation for combining the teachings of Lilly or Fields**, either individually or in combination.

**The Proposed *Lilly-Dietrich* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Dependent Claims 11, 24, and 39**

For example, with respect to dependent claim 11, this claim recites:

The method of Claim 2, further comprising:  
***monitoring the materials identified*** in the list of materials from outside parties distinct from the enterprise ***using one or more supply chain tools operable to monitor the outside parties***; and  
if one or more materials are determined to be unavailable using the one or more supply chain tools, ***automatically modifying the development schedule based on information obtained by the one or more supply chain tools***. (Emphasis Added).

Dependent claims 24 and 39 recite similar limitations. *Lilly* and *Dietrich*, either individually or in combination, fail to disclose each and every limitation of dependent claims 11, 24, and 39.

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that *Lilly* fails to disclose the emphasized limitations in dependent claim 11. Specifically the Examiner acknowledges that *Lilly* fails to disclose a ***scheduler*** for “***monitoring the materials identified*** in the list of materials from outside parties distinct from the enterprise ***using one or more supply chain tools operable to monitor the outside parties***; and if one or more materials are determined to be unavailable using the one or more supply chain tools, ***automatically modifying the development schedule based on information obtained by the one or more supply chain tools***.” (30 January 2006 Office Action, Pages 9-10). However, the Examiner asserts that the cited portions of *Dietrich* disclose the acknowledged shortcomings in *Lilly*. The Applicants respectfully disagree. The Applicants respectfully traverse the Examiner’s assertions regarding the subject matter disclosed in *Dietrich*.

The Applicants further respectfully submit that *Dietrich* has nothing to do with dependent claim 11 limitations regarding a **scheduler** for “**monitoring the materials identified** in the list of materials from outside parties” and “**automatically modifying the development schedule based on information obtained by the one or more supply chain tools**.” Rather *Dietrich* discloses a method that correlates sufficient capacity or material availability to meet requirements. (Column 4, Lines 40-45). *Dietrich* merely **discloses a comparison** of the requirements through production and if these requirements are met, then the external availability schedule corresponds to the requirements. This **comparison** in *Dietrich* does not teach, suggest, or even hint at the “**monitoring the materials identified** in the list of materials from outside parties”, as recited in dependent claim 11. In addition, this **comparison** in *Dietrich* does not teach, suggest, or even hint at the “**automatically modifying the development schedule based on information obtained by the one or more supply chain tools**”, as recited in dependent claim 11. Thus, *Dietrich* cannot provide a **scheduler** for “**monitoring the materials identified** in the list of materials from outside parties” and “**automatically modifying the development schedule based on information obtained by the one or more supply chain tools**”, since *Dietrich* does not even provide for the ability to monitor the materials, automatically modify the development schedule, or even use one or more supply chain tools.

The Applicants further respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Lilly* or *Dietrich*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art at the time of the invention **to incorporate Dietrich’s external availability schedule for materials into Lilly’s scheduling system**”. (30 January 2006 Office Action, Pages 9-10). The Applicants respectfully disagree.

The Applicants further submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Lilly* or *Dietrich*, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be ***"to account for all resources"*** available to generate a specific product thereby increasing the efficiency of the scheduling system." (30 January 2006 Office Action, Pages 9-10). The Applicants respectfully disagree and further respectfully requests clarification as to how the Examiner arrives at this conclusion. For example, how does ***"account[ing] for all resources"*** available to generate a specific product" directly increase the "efficiency of the scheduling system" and to what extent does the Examiner purport that "increasing the efficiency of the scheduling system" applies to the subject Application. ***The Applicants respectfully request the Examiner to point to the portions of Lilly or Dietrich which contain the teaching, suggestion, or motivation to combine these references for the for the Examiner's stated purported advantage.*** In particular, the Applicants respectfully request the Examiner to point to the portions of *Lilly* or *Dietrich* which expressly state that ***"monitoring the materials identified"*** in the list of materials from outside parties" accounts for all resources available to generate a specific product and that accounting for all resources increases the efficiency of the scheduling system. The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the ***Examiner has not adequately supported the selection and combination of Lilly or Dietrich to render obvious the Applicants claimed invention.*** The Examiner's conclusory statements that "it would have been obvious to one of ordinary skill in the art at the time of the invention ***to incorporate Dietrich's external availability schedule for materials into Lilly's scheduling system***" and ***"to account for all***

**resources** available to generate a specific product thereby increasing the efficiency of the scheduling system", **does not adequately address the issue of motivation to combine.** (30 January 2006 Office Action, Pages 9-10). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, **the Office Action fails to provide proper motivation for combining the teachings of Lilly or Dietrich**, either individually or in combination.

#### **The Proposed Lilly-Fields Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Dependent Claims 12, 25, and 40**

For example, with respect to dependent claim 12, this claim recites:

The method of Claim 2, **wherein each available resource in the list of available resources is associated with a resource definition comprising:**

the **capacity of the resource;**

**availability of the resource;** and

**ability of the resource** comprising attribute information identifying a type of work associated with the resource **and competency information indicating how well the resource performs the type of work identified in the attribute information.** (Emphasis Added).

Dependent claims 25 and 40 recite similar limitations. *Lilly* and *Fields*, either individually or in combination, fail to disclose each and every limitation of dependent claims 12, 25, and 40.

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that *Lilly* fails to disclose the emphasized limitations in dependent claim 12. Specifically the Examiner acknowledges that *Lilly* does not teach "**the required resources having an ability level or competency information indicating how well the resource performs the type of work identified.**" (30 January 2006 Office Action, Page 10). However, the Examiner asserts that the cited portions of *Fields* disclose the

acknowledged shortcomings in *Lilly*. The Applicants respectfully disagree. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in *Fields*.

The Applicants further respectfully submit that *Fields* has nothing to do with dependent claim 12 limitations regarding “***each available resource in the list of available resources is associated with a resource definition comprising: the capacity of the resource; availability of the resource; and ability of the resource*** comprising attribute information identifying a type of work associated with the resource ***and competency information indicating how well the resource performs the type of work identified in the attribute information.***” Rather, as discussed above, *Fields* discloses a staff scheduling data processing system. (Abstract). This data processing system in *Fields* is merely a database for storing and retrieving information associated with staff and management personal. The database in *Fields* merely stores and retrieves information characterizing skill levels required to perform tasks. However, *Fields* does not disclose, teach, or suggest “***each available resource in the list of available resources is associated with a resource definition***”, since the database in *Fields* does not even provide for a list of available resources associated with a resource definition in the first place. Thus, *Fields* cannot provide “***each available resource in the list of available resources is associated with a resource definition comprising: the capacity of the resource; availability of the resource; and ability of the resource*** comprising attribute information identifying a type of work associated with the resource ***and competency information indicating how well the resource performs the type of work identified in the attribute information.***”

The Applicants further respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Lilly* or *Fields*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art to include *Field's* specification of a skill level for each task



and subsequent skill levels of resources (employees).” (30 January 2006 Office Action, Page 10). The Applicants respectfully disagree.

The Applicants further submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Lilly* or *Fields*, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be “in order to **more efficiently allocate each resource to a task**” and by “allocating based on required skill level, each task would be **completed by the most qualified resource thereby ensuring highest quality products.**” (30 January 2006 Office Action, Page 10). The Applicants respectfully disagree and further respectfully requests clarification as to how the Examiner arrives at this conclusion. For example, how does completing each task “**by the most qualified resource**” ensure the “**highest quality products**” and to what extent does the Examiner purport that “**ensuring highest quality products**” applies to the subject Application. **The Applicants respectfully request the Examiner to point to the portions of Lilly or Fields which contain the teaching, suggestion, or motivation to combine these references for the for the Examiner’s stated purported advantage.** In particular, the Applicants respectfully request the Examiner to point to the portions of *Lilly* or *Dietrich* which expressly state that “allocating based on required skill level” ensures that “each task would be **completed by the most qualified resource**” and that this would ensure the “**highest quality products.**” The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the **prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the **Examiner has not adequately supported the selection and combination of Lilly or Fields to render obvious the Applicants claimed invention.**

The Examiner's conclusory statements that "it would have been obvious to one of ordinary skill in the art to include *Field's* specification of a skill level for each task and subsequent skill levels of resources (employees)" and that "in order to ***more efficiently allocate each resource to a task***" and by "allocating based on required skill level, each task would be ***completed by the most qualified resource thereby ensuring highest quality products***", ***does not adequately address the issue of motivation to combine***. (30 January 2006 Office Action, Pages 6-7). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the teachings of Lilly or Fields***, either individually or in combination.

#### **The Applicants Claims are Patentable over the Proposed *Lilly-Dietrich-Fields* Combination**

The Applicants respectfully submit that amended independent claims 2, 4, and 32 are considered patentably distinguishable over the proposed combination of *Lilly*, *Dietrich*, and *Fields*. *Lilly*, *Dietrich*, and *Fields* do not disclose, suggest or even hint at the unique and novel limitations disclosed in amended independent claims 2, 4, and 32. This being the case, independent claims 2, 4, and 32 are considered patentably distinguishable over the proposed combination of *Lilly*, *Dietrich*, and *Fields*.

With respect to dependent claims 5-30 and 33-45: claims 5-17 depend from amended independent claim 2; claims 18-30 depend from amended independent claim 4; and claims 33-45 depend from amended independent claim 32. As mentioned above, each of amended independent claims 2, 4, and 32 are considered patentably distinguishable over the proposed combination of *Lilly*, *Dietrich*, and *Fields*. Thus, dependent claims 5-30 and 33-45 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For the reasons set forth herein, the Applicants submit that claims 2, 4-30 and 32-45 are not rendered obvious by the proposed combination of *Lilly, Dietrich, and Fields*. The Applicants further submit that claims 2, 4-30 and 32-45 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 2, 4-30 and 32-45 under 35 U.S.C. § 103(a) be reconsidered and that claims 2, 4-30 and 32-45 be allowed.

#### **THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, ***and not based on applicant's disclosure.*** *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability,*** and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and

would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

**CONCLUSION:**


In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Continued Examination (RCE) is being filed in duplicate concurrently herewith to facilitate the processing of this deposit account authorization. **The Commissioner is hereby authorized to charge the RCE Fee of \$790.00 to Deposit Account No. 500777.** Because the Amendment After Final was filed within two (2) months of the date of the Final Office Action and this Amendment is filed prior to the ending of the response period 30 April 2006 of the Final Office Action mailed on 30 January 2006, no additional fees are deemed to be necessary; however, the undersigned hereby authorizes the Commissioner to charge any additional fees that may be required, or credit any overpayments, to **Deposit Account No. 500777.**

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

4/6/06  
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